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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,230	11/28/2003	Saul Katz	45496.20	1229

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EXAMINER	
PRATT, HELEN F	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
10/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/707,230	KATZ ET AL.	
	Examiner	Art Unit	
	Helen F. Pratt	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 8-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 8-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 10, 11, 15, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbert (5,776,887).

Wilbert et al. disclose a composition containing the claimed ingredients as in claims 1, 10, 11 and 15. The carbohydrate content is seen to have been more than 50% as in claims 1, 10 and 11 because rolled oats, which are a complex carbohydrate with a low GI is used in predominant amounts and the reference discloses 62% carbohydrates (col. 8, lines 40-60.). Also, the GI is seen to have been within the claimed amounts of 1, 10, 11 and 15, due to the use of complex carbohydrates absent a showing to the contrary. Therefore, it would have been obvious to use known ingredients, and known amounts of COH and a GI absent a showing to the contrary.

The limitations of claims 16 and 18 have been disclosed above and are obvious for those reasons.

As to claim 17, Wibert et al. disclose the composition in the form of a granola bar, which is for humans (col. 8, lines 35-60). Therefore, it would have been obvious to administer a composition containing complex carbohydrates to humans.

Claims 1, 8, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid (6,458,378).

Sunvoid disclose a composition as in claim 1 for improving glucose metabolism in animals by controlling the insulin response, which contains a source of protein, fat, and carbohydrates (abstract). The carbohydrates in the food item are greater than 45% by weight. Grains are not considered to be rapidly absorbed carbohydrates, since they contain a lot of fiber, which keeps the carbohydrates from being rapidly absorbed (col. 8, lines 35-60). Claims 1 and 8, 10, 11 differ from the reference in the particular glycemic index (GI). Sunvoid discloses the use of a composition containing grains, which is seen to have produced a composition with a GI lower than 50 since grains are used in the composition and no simple sugars or sucrose. Therefore, it would have been obvious to make a composition using the claimed ingredients.

Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid as applied to the above claims, and further in view of Wilbert (6,458,378).

Claim 9 further requires that the composition contains inulin, but not a starch. However, Wilbert discloses that it is known to use inulin in a diet, which controls the GI (col. 3, lines 50-59). Therefore, it would have been obvious to use a known source of fiber in the composition of Sunvoid for its known function.

Claims 1, 10, 11, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nidetch (* Weight Watchers), pages 218, 219, Cheddar Muffins.

Nidetch disclose a composition containing protein, fat and carbohydrates where the total carbohydrate content is more than 45% as in claims 1 and 10. Casein is the major protein found in cheddar cheese and skim milk as in claim 14. The claims differ from the reference as to the particular GI. However, the GI is seen to have been less than 40 as in claims 1, 10, 11 and 14 and less than 35, as in claim 13 since the composition has been shown (pages 218, 219). Therefore, it would have been obvious to make a composition containing the claimed ingredients and glycemic index.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid in view of Wilbert, and further in view of Foster-Power International Table of Glycemic Index.

Claim 16 further requires that the composition is a food item with particular amounts of ingredients. However, it is seen that it would have been within the skill of the ordinary worker to determine the amounts of carbohydrate and the glycemic index of various foods and to make a composition with known ingredients which was within the claimed limitations especially as applicants have provided in their Information Disclosure Statement a table of Foods which shows the glycemic index of various foods. Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Also, Painter discloses the value of using the GI to determine which foods would have been desirable for people and that "an energy bar could be designed with COH's that provide a low glycemic response using fructose and that the GI can be accurately estimated from food (page 04, 1st col. 2nd paragraph, page 07, first para., col. 2.). Therefore, it would have been obvious to choose various foods with known amounts of carbohydrate and a known glycemic index in which to make a food composition.

ARGUMENTS

Applicant's arguments filed 9-17-07 have been fully considered but they are not persuasive.

Applicants argue that Wibert et al. addresses a different problem of controlling absorption of carbohydrates during digestion by diabetics. However, applicants' claims are to a composition, which does not require that the food is for a specific condition and

even if an intended use were found in the claim, it is not given weight in a composition claim.

Applicants argue that the use of sucrose in the composition of Wibert would not be a desirable ingredient in the claimed composition. However, it is noted that sucrose is used "optionally" in example 1, col. 8. Also, "sucrose" is not excluded from the claim. It is not seen that Wibert et al. teach away from a low glycemic composition, when no showing has been made to show what the GI would have been for Wibert et al. as the office is not in a position to do so. Once the rejection has been made, the burden is on Applicants to show that their glycemic index is not shown.

Applicants argue that a prima facie case has not been shown, however, as above, nothing has been provided to show what the glycemic index of even of the granola bar of Ex. One.

Applicants argue that the reference to Sunvold is for pet compositions, and that they often contain ingredients unfit for human consumption. However, as above, nothing has been shown by way of showing what the glycemic index of Sunvold is. It would have been within the skill of the ordinary worker to use foods, which are suitable for humans. Choosing foods, which result in a particular glycemic index is not seen as inventive, as whole books are published on the GI of foods, and to pick and choose foods, that are tasty and nutritious is not seen as inventive as in In re Levin.

Applicants argue that there is no motivation to combine the references of Wibert et al. and Sunvold. However, each reference is used for what it teaches and it is known

to use inulin in a diet for controlling blood sugar because the glycemic index is also useful in controlling blood sugar.

Applicants argue that that a teaching of a single ingredient cannot be said to control the glycemic index as in Sunvold in view of Wibert. However the passage referred to states that fiber can comprise from 1 to 95% total carbohydrate and one of the fibers can be inulin. Certainly a fiber with a GI of less than 2 is not going to contribute to the GI much. Inulin is cited because claim 9 requires inulin.

Applicants argue that Nidetch does not disclose the claimed GI index. However, as above, Applicants do not say what the GI is. In order for a patent to issue, these references must be overcome, and mere statements do not suffice.

Applicants argue that considerable time has gone into formulating the claimed invention. However, it is not known whether the cited food bars have patents. As above, picking and choosing low glycemic foods is not seen as inventive because nothing new or unobvious results.

Each of the ingredients in the composition are known foods used for their known function. For instance, it is well known that fructose does not have the same GI as does glucose. Certainly caseinate has a low GI because it is a protein, and on.

Applicants argue to a specific blend and combination of ingredients as in claim 16. However, as above, nothing new is seen in picking and choosing known foods for their known affects on the GI.

As to the various ingredients, they are all well known. In particularly 'almond butter is not claimed, but almonds. All the other ingredients are well known.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 10-25-07

H. Pratt

HELEN PRATT
PRIMARY EXAMINER